

REMARKS

Favorable consideration and allowance are respectfully requested for claims 1-10 and 12-15 in view of the foregoing amendments and the following remarks.

New claims 16 and 17 depend from claim 1 and relate to methods where two or more sets of large capturing particles are provided in a chamber (claim 16) or two or more chambers are expressly provided (claim 17).

The rejection of claim 14 under 35 U.S.C. § 112 as indefinite for lacking proper antecedent basis is respectfully traversed. As suggested by the Examiner, claim 14 is amended to recite the "large-capturing particle" rather than the "large particle". Reconsideration and withdrawal of this rejection are respectfully requested.

The rejection of claims 1-10 and 12-15 under 35 U.S.C. § 103 as obvious over Chandler (6,268,222) in view of Hansen (WO 00/11449) is respectfully traversed.

Claim 1 is amended to recited that the large-capturing particles are contained in at least one chamber through which the sample can be passed. Support for this amendment can be found in the specification, for instance in paragraph [0002]. Claim 1, the only independent claim, relates, in part, to a method where a sample is incubated in at least one chamber with at least one set of large-capturing particles. The large-capturing particles are able to bind or capture molecules, cells or other particles in the sample. The large capturing particles containing bound molecules, cells or other particles are then sorted from each other and the molecules, cells or other particles are detached from the large-capturing particles.

In the recent Office Action, the Examiner admits that Chandler does not disclose the steps of "sorting from each other the large-capturing particles containing specifically bound molecules, cells or other particles" (claim 1).

The Examiner asserts that Hansen makes up for this limitation by reciting that "[a]part from multicellular organisms, large microspheres used in combinatorial chemistry to produce libraries of test compounds are preferred objects to be analyzed and deposited by the instrument of the present invention." See Hansen on page 37 at lines 15-18. This does not make up for the failure of Chandler to teach that the large-capturing particles are separated

from each other. Further, the references do not appear to teach that the large-capturing particles are contained in a chamber through which the sample is passed. Rather, in Hansen, for instance, the sample is in a fluid that is passed single file through a sorter and the fluid is then redirected. See pages 9-12.

Finally, even assuming, *arguendo* that the cited references did teach all of the claim limitations, the Federal Circuit has said that:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

In re Geiger, 815 F.2d 686, 688, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987). There is no teaching or incentive supporting the specific combination of steps found in the claims. The rejection of these claims appears to be improperly based on a piecing together of the elements of the claims using the claims as a guide. The prior art simply does not suggest the claimed processes and provides no motivation to a person of skill in the art to arrive at such a combination of steps.

Moreover, as stated in the *Manual of Patent Examining Procedure* (MPEP), a *prima facie* case of obviousness requires a suggestion or motivation to one of ordinary skill in the art to combine the references. See § 706.02(j), Patent and Trademark Office, U.S. Department of Commerce, MPEP, § 706.02(j) (8th ed., Rev. 2, May 2004). On the present record, there is no showing of a suggestion or motivation to combine the references. Accordingly the claims are not rendered obvious and reconsideration and withdrawal of the rejection are respectfully requested.

CONCLUSION

In view of the foregoing, the application is respectfully submitted to be in condition for allowance, and prompt favorable action thereon is earnestly solicited.

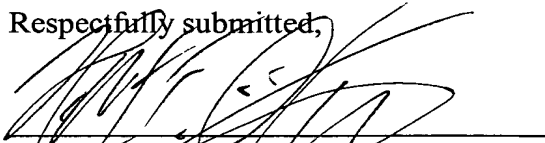
If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

Application No.: 09/920,727
Reply dated February 17, 2005
Response to Office Action dated November 17, 2004

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Attorney Docket No. 010770.49121US).

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Respectfully submitted,



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